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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/603,549      | 06/25/2003  | Boney A. Mathew      | 65,164-022          | 5449             |

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EXAMINER

ORTIZ, ANGELA Y

ART UNIT PAPER NUMBER

1732

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/603,549 | <b>Applicant(s)</b><br>MATHEW ET AL. |  |
|                              | <b>Examiner</b><br>Angela Ortiz      | <b>Art Unit</b><br>1732              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4 and 7-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 7-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The amendment filed 20 December 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment inserts the phrase "expandable polymer that includes and is not limited to" into paragraph [0017]. This phrase is not supported by the original specification, and must be canceled or deleted from the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4, 7-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now sets forth "expandable polymer", and this limitation is not supported for the reasons discussed above.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 4, 7-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelman, USP 5,200,252 in view of Murray, USP 4,536,116 (both of record).

The cited primary reference substantially teaches the basic claimed method of composite molded plastic article including molding an insert for a molded plastic part comprising the steps of molding an expandable polymer and forming fastener means, thus enabling the final molded product to be attached after molding. An outer skin 14 is placed in a mold cavity; typically the skin is preformed but can be formed in the mold cavity also. A foam mold 40 is provided, and a foaming resin is supplied or poured into the mold cavity, and is molded integrally with the skin. Fibrous material may be included to form a reinforced article. Bosses 18 and 20 are formed either during foaming, or separately and attached by molding or another similar step. See col. 4, lines 1-10, 17-25, 35-55; col. 5, lines 1-30.

The cited primary reference does not teach providing an insert per se and injecting a part composition as claimed.

The added secondary reference teaches as conventional the feature of molding a composite molded plastic part wherein a nut insert is molded within a plastic part. The nut is placed within a mold cavity, a plastic part is attached to the nut on a bottom and side(s) of the nut, wherein the nut may be assembled to a pin, and plastic, readable on

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a part composition, is injection molded around the nut and the plastic part to form an assembly and forms a tight grip on the assembly. The nut is provided with a threaded bore for making attachment with a threaded element more facile. See col. 2, lines 20-45; col. 3, lines 45-60; col. 4, lines 45-68; col. 5, lines 5-23, 45-65; col. 6, lines 1-8, 15-20.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a nut or insert as claimed when molding the fastening means, and a part composition in view of the added reference, when performing the process set forth in the primary reference, for forming the fastening means assembly with a threaded bore for attachment or engagement with a threaded element, and for molding a plastic part which forms a tight grip on the nut assembly.

With respect to claimed materials and the insulating property, including plastics, filler and pigmented materials, note that the disclosed materials are equivalent to the claimed materials; for example, see foam material layer 12 of the primary reference, and USP 4,536,116 at col. 6, lines 16-30. Note that the foam material is insulating and compressive also, being the same as described in the instant specification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include any number of conventional materials for achieving equivalent results.

With respect to the fastening means used, note that the secondary reference sets forth metal parts of conventional shape and design, see USP '116 at col. 3, lines 30-55.

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With respect to the shape of the insert and the plastic part being molded, note the shape of the molded part and insert are obvious design choices and are well within the choice of the practitioner of the method, and within the level of ordinary skill in the art.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 4, 7-22 have been considered but are moot in view of the new ground(s) of rejection.

Note that the amendment introduced new matter, and has been met by the newly applied prior art rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

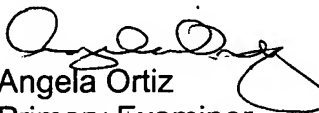
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 571-272-1206. The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Angela Ortiz  
Primary Examiner  
Art Unit 1732

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